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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,011	12/30/2003	Matthias Krull	1997DE419/DIV/C	6488

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

PEZZUTO, HELEN LEE

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,011	Applicant(s) KRULL ET AL.	
	Examiner Helen L. Pezzuto	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/30/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-34 is/are rejected.
- 7) ☒ Claim(s) 14-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/207,219.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Upon further consideration, the notice of allowance mailed on 5/4/04 is herein vacated and the allowance of the inventive subject matter expressed in claims 13-34 is herein withdrawn.

Prosecution on the merits of this application is reopened on claims 13-34 considered unpatentable for the reasons indicated below:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 13 and claims dependent thereon are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The upper limit of 100 mPas in "copolymer having a melt viscosity measured at 140°C of between 30 and 100 mPas" expressed in claim 13 lack adequate description in the original

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specification. While the lower limit for this range clearly has written descriptive support in the original disclosure, the upper limit does not. On page 8, lines 16-21, the preferred ranges for the melt viscosity and the lowest limit given is 1000 mPas. In the working examples of the invention, the melt viscosities are higher than 100 mPas, with the lowest exemplified being 195 mPas (Example 3). Accordingly, claim 13 and claims dependent thereon failed to comply with the written description requirement.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 13 and claims dependent thereon are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 203554 A.

As described in applicant's specification (page 2, lines 21-24), EP-554 discloses a terpolymer of ethylene, diisobutylene, and vinyl acetate. The diisobutylene and vinyl acetate embrace the instant "at least two further olefinically unsaturated comonomers" expressed in claim 13. The abstract of EP-544 states the terpolymers having a melt viscosity at 140°C of 100-1000 mPas. While the reference does not appear to be specific embodiment that has a melt viscosity of 30 mPas, the disclosed lower limit of 100 mPas anticipates or renders obvious such a limitation. Absent a showing of criticality of the process steps, the instant product by process claims are rejected over prior art products containing the same product limitation as applicant, in particular, those expressed in claims 13, 20, 23, 26-34. The burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ, and that the process imparts some structural difference from the prior art. At this juncture, the comparative data of record is not clear whether the results are due to the process itself which

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provides structural features not obtainable in any other way or the composition of the resulting polymer such that the composition could not be formed in the process disclosed by EP-554. Furthermore, evidence presented in comparative showings must be clear and convincing in a manner that any showing of unexpected results must be commensurate in scope with a given claim.

Claim Objections

6. Claims 14-15 are objected to, for having a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim). In the present instance, claims 14-15 recites the broad recitation comonomer and initiator content, and the claim also recites the "preferably" lower ranges, which is the narrower statement of the range/limitation. The examiner suggests expressing the preferred range in separate dependent claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached

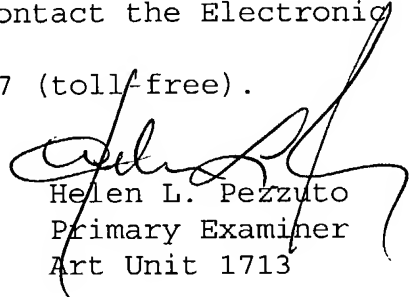
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on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp